

Applicants request reconsideration of the application in the light of the following remarks.

## REMARKS

### CLAIM OBJECTIONS

The claims are amended to incorporate changes suggested by the examiner with grammatical corrections where required. The amendments do not add new matter and do not affect the breadth of the claims.

### 35 U.S.C. 103(a) REJECTIONS

*Clendenin et al. and Lucas et al.*

*CLAIMS 1, 13-14, 18-19*

#### *Claim 1*

Clendenin et al. discloses a camera 22 which rotates as part of the sight assembly 10 about a mast. Col. 1, line 6 - col. 2, line 2. This corresponds to a "pan" type of operation. Clendenin et al. does not disclose a camera that can both pan and tilt as claim 1 specifies.

Clendenin et al. discloses a control panel assembly 50 containing display monitor 60 and push button switches 68 which control system power, laser power, and the selection of a direct or stabilized mode of operation. Col. 12, lines 10-14, 27-31. Clendenin et al. discloses a joystick 52, separate from control panel assembly 50, which an operator uses to control the movement of

the camera. Fig. 10; col. 12, line 64 - col. 13, line 4. Thus, Clendenin et al. does NOT disclose a "display-control box having an image display screen and control buttons for controlling said camera and its movement" as specified in claim 1.

Clendenin et al. discloses: "A control panel assembly along with electronic units may be mounted in the cabin of a helicopter for use by the operator." Col. 2, lines 5-7. Clendenin et al. does NOT disclose a "display-control box being attached to an adjustable mount in said vehicle within an operator's view and reach", as specified in claim 1.

Clendenin et al. does NOT disclose "an image capture box for receiving said captured mobile images" as specified in claim 1. The examiner suggests that it would be obvious to one skilled in the art to incorporate a video recorder disclosed by Lucas et al. in the Clendenin et al. invention. The Clendenin et al. invention is a target designation system intended for use on tanks and helicopters. Col. 1, lines 58-66, Figs. 2 and 3. The Lucas et al. invention is intended to document law enforcement activities by providing a video recording of an arrest and the circumstances preceding the arrest. Col. 1, lines 13-17. The examiner argues that a person skilled in the art would be motivated to incorporate Lucas et al.'s video recorder in Clendenin et al.'s target designation system "in order to provide own record of events of a person for private purposes, such as for providing proof of insurance claims."

It is unlikely that a person considering ways of improving Clendenin et al.'s battlefield target designation system would be motivated to include a video recorder in order to provide proof of insurance claims.

**"The legal concept of *prima facie* obviousness is a procedural tool of examination which applies broadly to all arts. . . . The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. . . . To establish a *prima facie* case of obviousness,**

three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." MPEP § 2142.

The prior art cited by the examiner does not disclose the "fully-rotatable camera" limitation and the "display-control box" limitation. Nor does the examiner explain why a person skilled in the art would be so concerned about documenting insurance claims in a battlefield situation as to be motivated to combine Lucas et al.'s image capture box with Clendening et al.'s battlefield target-designation system.

"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.

The prior art cited by the examiner does not disclose the limitations of claim 1. Since the limitations of claim 1 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 1.

### ***Claim 13***

Clendenin et al. discloses a sight assembly 10 rotatably mounted on the mast (col. 1, lines 61-62), camera 22 always remaining in a fixed position relative to the sight assembly 10 (Fig. 5). Since the sight assembly 10 cannot be tilted, neither can the camera. Thus, Clendenin et al. does

not disclose a Field of View stabilized camera as specified by claim 13. The Field of View of Clendenin et al.'s sight assembly 10 can be adjusted horizontally by rotation about the mast and vertically by means of mirror 12 and consequently, one might describe sight assembly 10 as being Field of View stabilized. However, a Field of View stabilized sight assembly is not the same as a Field of View stabilized camera as specified by claim 13.

Clendenin et al. says nothing about "electronic compensation to overcome mechanical gear backlash and vibration" as claim 13 requires.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 13. Since the limitations of claim 13 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 13.

#### ***Claim 14***

Clendenin et al. does not disclose a system wherein the camera can be mounted at any angle with respect to gravity as specified in claim 14. The examiner cites Figs. 2 and 3 as disclosing this feature, but Figs. 2 and 3 only shows the system mounted on a vertical mast attached to a helicopter and tank respectively.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165**

**USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 14. Since the limitations of claim 14 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 14.

***Claim 18***

Clendenin et al does not disclose a display-control box which has a set of control buttons POSITIONED TO BE OPERATED WITH A SINGLE HAND as specified by claim 18. The passage cited by the examiner says only that the operator "may control the sight assembly manually."

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 18. Since the limitations of claim 18 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 18.

***Claim 19***

Clendenin et al. does not disclose a display-control box having a viewing angle adjustment lever positioned to be operated with a single hand as specified by claim 19. The

passage cited by the examiner says only that the operator "may control the sight assembly manually." Fig. 10 does not show a display-control box having a viewing angle adjustment lever.

The prior art cited by the examiner does not disclose the limitations of claim 19. Since the limitations of claim 19 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 19. Since the limitations of claim 19 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 19.

*Clendenin et al., Lucas et al., and Klapper et al.*

*CLAIMS 2, 5-6, 22, and 24*

***Claim 2***

The examiner argues that the pan and tilt arrangement of Klapper et al. could be incorporated in Clendenin et al.'s invention, thereby achieving a full-rotation capability of the camera "by mounting said camera to a tilting mechanism mounted on a panning mechanism" as specified in claim 2.

This modification of Clendenin et al.'s invention would result in the Clendenin et al.'s invention being inoperable. Videcon camera 22 must be in a fixed position relative to optical

system 20 in order for the Clendenin et al. system to work and consequently, videcon camera 22 cannot be made fully-rotatable and still preserve the integrity of the Clendenin et al. design.

**"If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)." MPEP § 2143.01.**

**"If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d, 123 USPQ 349 (CCPA 1959)." MPEP § 2143.01.**

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 2. Since the limitations of claim 2 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 2.

### ***Claim 5***

Klapper et al. does not disclose a water seal attached to the tilting mechanism (see Fig. 3). The passage cited by the examiner (col. 13, lines 65-67) refers to a "water-resistant case", not the tilting mechanism.

Whether or not Klapper et al. discloses a water seal attached to the tilting mechanism is irrelevant in any case since incorporating Klapper et al.'s pan and tilt mechanism in the

Clenedenin et al. invention would make the Clendenin et al. invention unsatisfactory for its intended purpose.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 5. Since the limitations of claim 5 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 5.

#### ***Claim 6***

The examiner cites Klapper et al. as disclosing applicants' mount assembly adapted to engage a roof-rack of a vehicle as specified in claim 6.

Klapper et al. does not disclose a camera having a mounting assembly adapted for use with commercially-available roof-rack systems. Klapper et al. discloses custom mounting hardware 1012 that can secure a camera to the roof of a vehicle—not to the roof-rack of the vehicle. Col. 3, lines 48-50; Col. 4, lines 1-4. The "custom" nature of the mounting hardware is indicated by the center support 1014 which has mounting holes that match the pointing mechanism 500. Klapper et al.'s night vision camera 1 and pointing mechanism 500 are not adapted for mounting to commercially-available roof-racks.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165**



**USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 6. Since the limitations of claim 6 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 6.

***Claim 10***

The examiner cites Klapper et al. as having disclosed applicants' claim-10 "singular support for both pan and tilt mechanisms." The adjective "singular" in the context of applicants' invention means that both the pan mechanism and the tilt mechanism are supported at only one end of the axis of rotation. Klapper et al. does not disclose singular support for either the pan or the tilt mechanism. Klapper et al., col. 4, lines 57-59. Klapper et al. also does not disclose the slip clutches specified in claim 10. The slip ring and brush assembly 536 identified by the examiner are not slip clutches.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 10. Since the limitations of claim 10 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 10.

**Claim 22**

The examiner cites Klapper et al. as disclosing applicants' mount assembly as including an adapter plate to mate to a light bar used on emergency and patrol guard vehicles as specified in claim 22.

Klapper et al. does not disclose a camera having a mounting assembly which includes an adapter plate to mate to light bars used on emergency and patrol guard vehicles. Klapper et al. discloses custom mounting hardware 1012 that can secure a camera to the roof of a vehicle—not to the light bar of the vehicle. Col. 3, lines 48-50; Col. 4, lines 1-4. The "custom" nature of the mounting hardware is indicated by the center support 1014 which has mounting holes that match the pointing mechanism 500. Klapper et al.'s night vision camera 1 and pointing mechanism 500 are not adapted for mounting to light bars on emergency vehicles. Fig. 1 does not show a light bar on the automobile and Fig. 2 shows mounting hardware for mounting Klapper et al.'s night vision system to a car's roof, not to a light bar. Col. 1, lines 25-27, does not say anything about mounting Klapper et al.'s night vision system to a light bar.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 22. Since the limitations of claim 22 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 22.

***Claim 24***

Klapper et al. does not disclose a mount assembly which includes an adapter plate for ship-board attachment. Fig. 15 (cited by the examiner as such a disclosure) does not show an adapter plate nor does the discussion of Fig. 15 (col. 13, lines 41-52) disclose an adapter plate.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 24. Since the limitations of claim 24 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 24.

*Clendenin et al., Lucas et al., and Paddock et al.*

***CLAIMS 3-4 and 8-9***

***Claim 3***

Paddock et al. does not disclose a mount assembly which incorporates a quick disconnect mechanism which allows the mount assembly to be quickly disconnected from the vehicle to which it is attached. The mount assembly corresponds to Paddock et al.'s camera support system which includes support apparatus 10 (which attaches to an operator) and camera support 20. Paddock et al.'s operator corresponds to applicants' vehicle. Paddock et al. does not disclose a quick disconnect mechanism which allows the support apparatus 10 to be quickly disconnected from the operator.

The examiner cites a quick release mechanism which quickly disconnects the camera from a mount assembly, but this is not the quick disconnect mechanism which quickly disconnects the mount assembly from the vehicle as specified in claim 3.

Even if Paddock et al. has disclosed a quick disconnect mechanism incorporated in the mount assembly, there is no motivation for a person skilled in the art to incorporate such a quick disconnect mechanism in the Clendenin et al. invention that would allow the mast to be quickly disconnected from the helicopter or tank. The examiner argues that such a quick disconnect would save time, but if saving time is so important in this context, why is there no hint of the need for saving time in any of the references?

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 3. Since the limitations of claim 3 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 3.

#### ***Claim 4***

The examiner cites Paddock et al. as disclosing applicants' claim-4 limitation wherein said mount assembly includes a double locking mechanism. However, Paddock et al. states:

"The quick release mechanism, when it is open, allows the mounting plate to be mounted to the adjustable platform. When the locking screw is loosened, the quick release

mechanism slidably secures the mounting plate to the adjustable platform. When the locking screw is tightened, the quick release mechanism secures the mounting plate to the adjustable platform." Paddock et al., col. 3, lines 60-67

Note that when the locking screw is loosened, the quick release mechanism slidably secures the mounting plate to the adjustable platform. The mounting plate is not locked to the adjustable platform if it is slidably secured. Thus, the locking screw is the only means provided for locking the mounting plate to the platform.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 4. Since the limitations of claim 4 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 4.

### ***Claim 8***

The examiner cites Paddock et al. as disclosing applicants' "ball-plunger for self-locking." However, Paddock et al. states:

"The ball-plunger 80 of the screw 79 engages one of the notches 81, . . . , of the cam lever 73 when the cam lever 73 is in its closed position . . . in order to provide a stop therefor. When the cam lever 73 is in its open position . . . the ball-plunger 80 of the

screw 79 engages the other notch 81, . . . , of the cam lever 73 in order to provide a stop therefor." Paddock et al., col. 7, lines 37-45.

Providing a "stop" is not the same as performing a "self-locking" function.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 8. Since the limitations of claim 8 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 8.

#### ***Claim 9***

Claim 9 specifies "a security fastener as a secondary and operator activated mechanical locking mechanism." Paddock et al.'s "locking screw 77" is not a security fastener (releasable only with a special key). Also, since Paddock et al. does not disclose a double locking mechanism (see claim 4 discussion above), Paddock et al. also does not disclose applicants' "security fastener as a secondary and operator activated mechanical locking mechanism."

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 9. Since the limitations of claim 9 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 9.

*Clendenin et al., Lucas et al., Klapper et al., and Sclater*

*CLAIMS 7 and 21*

*Claim 7*

The examiner cites Sclater as disclosing applicants' mount assembly adapted to engage a THULE® brand roof rack system as specified in claim 7.

Sclater does not disclose how to mount anything remotely like applicants' mount assembly on a THULE® brand roof rack system. Sclater discloses how a collapsible frame assembly can be attached to a PAIR of THULE® or YAKIMA® roof-top carriers using commercially-available parts:

"The collapsible frame assembly 10, placed into a carrier pocket 32 (an accessory such as, for example, a ski carrier) of the universal carrier mounting 14 and is secured by a suitable means therein. Each of the universal carrier mountings 14 has straps 26 which tighten and position the universal carrier mounting 14 on the roof-top of the vehicle 12 and may further be used to secure secondarily the collapsible frame assembly 10 to the universal carrier mounting 14." Col. 3, lines 50-59.

Tying down a collapsible frame assembly to a pair of roof-rack carriers is not a disclosure of something like applicants' mount assembly being adapted to engage a THULE® brand roof-rack system.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 7. Since the limitations of claim 7 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 7.

#### ***Claim 21***

The examiner cites Sclater as disclosing the mating of applicants' mount assembly to a YAKIMA® brand roof rack system as specified in claim 21.

Sclater does not disclose how to mate anything remotely like applicants' mount assembly to a YAKIMA® brand roof rack system. Sclater discloses how a collapsible frame assembly can be attached to a PAIR of THULE® or YAKIMA® roof-top carriers using commercially-available parts:

"The collapsible frame assembly 10, placed into a carrier pocket 32 (an accessory such as, for example, a ski carrier) of the universal carrier mounting 14 and is secured by a suitable means therein. Each of the universal carrier mountings 14 has straps 26 which tighten and position the universal carrier mounting 14 on the roof-top of the vehicle 12



and may further be used to secure secondarily the collapsible frame assembly 10 to the universal carrier mounting 14." Col. 3, lines 50-59.

Tying down a collapsible frame assembly to a pair of roof-rack carriers is not a disclosure of something like applicants' mount assembly being mated to a YAKIMA® brand-roof rack system.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 21. Since the limitations of claim 21 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 21.

*Clendenin et al., Lucas et al., Klapper et al., and Kurian*

### *CLAIM 11*

Kurian does not disclose (see Figs. 1, 2) a slip clutch comprising (1) a rotationally free gear, (2) a support housing for gear, (3) a friction pad co-aligned to said gear between said gear and said support housing, and (4) a wave washer to apply a pressure against said rotationally free gear and said support housing of sufficient force to enable a motor to drive said gear and said support housing to a point where said support housing stops rotating and said rotationally free gear breaks friction of said friction pad while said motor continues to drive without overheating.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging**

the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.

The prior art cited by the examiner does not disclose the limitations of claim 11. Since the limitations of claim 11 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 11.

*Clendenin et al., Lucas et al., Sergeant et al., and Kennedy et al.*

### *CLAIMS 12, 16*

#### *Claim 12*

The examiner cites Kennedy et al. as disclosing applicants' "camera enclosure with bezel opening that is threaded to accept optical filters." The passage cited by the examiner is:

"A 1.5 micrometer edge filter 34 along with a 0.7 neutral density optical filter 36 are placed in the lens." Kennedy et al., col. 5, lines 23-24.

Note that the passage describes placing the filter in the lens, not the camera enclosure 20. The passage does not say anything about a bezel opening threaded to accept optical filters. In short, Kennedy et al. does not disclose the claim-12 limitation quoted above.

The examiner cites Sergeant et al. as disclosing applicants' "o-ring" for sealing the optical filter in a bezel opening in the camera enclosure. But Sergeant et al.'s o-rings are used to seal the ends of the camera enclosure and have nothing to do with sealing an optical filter into an opening in the camera enclosure. Sergeant et al., Abstract. The combination of Kennedy et al. and

Sergeant et al. results in a camera within a camera enclosure, the camera having an optical filter within the lens of the camera and the camera enclosure ends sealed with o-rings. Compare this combination with applicants' camera within a camera enclosure, the camera enclosure having a threaded bezel opening to accept an optical filter, the filter being sealed in the bezel opening with an o-ring.

The combination proposed by the examiner is not the invention claimed by applicants in claim 12. If the combination of the prior art does not result in applicants' claimed invention, there can be no issue of obviousness.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 12. Since the limitations of claim 12 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 12.

### ***Claim 16***

Kennedy et al. does not disclose a camera enclosure which is adapted to act as an additional heat sink. In stabilizing the temperature within the camera enclosure, heat from the primary heat source within the camera enclosure can be guided to the camera enclosure, which thereby acts as a heat sink. A heat sink is something that is capable of absorbing heat such as applicants' camera enclosure which is made of a thermally conducting material. Kennedy et al.'s

protective enclosure 20 is made of a material having low heat conductivity (col. 5, lines 6-9) and thereby resists the absorption of any significant amount of heat and cannot therefore act as a heat sink.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 16. Since the limitations of claim 16 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 16.

*Clendenin et al., Lucas et al., and Baumeister*

*CLAIM 15*

Baumeister does not disclose a BIMETAL heat sink as specified in claim 15.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 15. Since the limitations of claim 15 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 15.

*Clendenin et al., Lucas et al., and Balkwill et al.*

*CLAIM 17*

The examiner cites Balkwill et al. as disclosing applicants' camera enclosure that "incorporates a one-way moisture passage plug with flexible and sealed passage for wires."

Balkwill et al.'s invention is described as follows:

"The present invention provides a cover for an electrical box having a fastening flange extending outwardly therefrom to be fastened to a structural member in the wall or ceiling. The cover extends completely around the side walls and the back wall of the box and has a flexible, thin-wall flange slanting away from the cover so that the peripheral edge of the flange can tightly contact the back surface of the wall or ceiling panel in which the box is mounted. In this manner, air and water or moisture are prevented from entering through the box itself and also around the box through the opening in the wall or ceiling in which the box is mounted. Similarly, heated air is prevented from escaping."

Balkwill et al., col. 1, lines 28-40.

A "flexible, thin-wall flange slanting away from the cover so that the peripheral edge of the flange can tightly contact the back surface of the wall or ceiling panel" prevents air, water, and moisture from either entering or leaving the box. It does not enable the flow of moisture in only one direction as called for by the claim.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165**

USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.

The prior art cited by the examiner does not disclose the limitations of claim 17. Since the limitations of claim 17 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 17.

*Clendenin et al., Lucas et al., and Tovi*

*CLAIM 20*

Tovi does not disclose an optically clear or tinted sphere enclosing a camera as specified in claim 20. Tovi discloses a globe 12 which is coated with matte or glossy black paint 58 over a large portion of the interior of the globe. Col. 5, lines 25-28. Black paint does not produce a clear or tinted sphere.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 20. Since the limitations of claim 20 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 20.

*Clendenin et al., Lucas et al., Klapper et al., and Yang*

*CLAIM 23*

Yang does not disclose a camera mount assembly which is adaptable to a railroad locomotive attachment as specified in claim 23. The examiner cites Fig. 17 and col. 8, lines 1-5 as disclosing this limitation but apparently overlooked col. 7, lines 67-68, which together with the material cited by the examiner states that "video surveillance system 132 comprises a video transmitter 134 on board SATELLITE CAR 12 . . . [which] comprises a camera 138. Nothing is said about the camera mounting system being adaptable to mounting on the satellite car 12 let alone to mounting on the locomotive of train 10.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 23. Since the limitations of claim 23 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 23.

*Clendenin et al., Lucas et al., and Kujirada*

*CLAIM 25*

None of the references describe the mounting of a camera to a vehicle wherein the camera is equipped with a mount assembly which is adaptable to being mounted on an automobile, ship,

or railroad locomotive. Only Clendenin et al. discusses the mounting of a camera on a vehicle and only states that it can be mounted on a vehicle such as a helicopter, tank, or other such land type vehicle and involves a mast "to elevate a sight assembly 10 above elements of the terrain. Col. 5, lines 47-53. Nothing is said about the mounting of the camera being adaptable to a variety of types of vehicles.

**"To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970)." MPEP § 2143.03.**

The prior art cited by the examiner does not disclose the limitations of claim 25. Since all of the limitations of claim 25 are not disclosed by the prior art, there is no way that a person skilled in the art would be motivated to incorporate such limitations in the Clendenin et al. invention.

The examiner has not established the *prima facie* obviousness of claim 25.

\* \* \* \* \*

Claims 1-25 are believed to be in condition for allowance and such action is respectfully requested.

Respectfully submitted,



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